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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

99477-US-NP

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on September 8, 2005

Signature _____

Typed or printed name Caroline Benson

Application Number

09/472,762

Filed

12/27/1999

First Named Inventor

Carl H. Hauser

Art Unit

2154

Examiner

Kenny S. Lin

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).


Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 39,159
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

Daniel B. Curtis

Typed or printed name

650-812-4259

Telephone number

September 8, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".

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Caroline Benson

Signature:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

As noted on the transmittal form accompanying this document, Applicant requests a pre-appeal brief conference to review the legal and factual basis of the rejections in the final Office Action mailed June 9, 2005 in U.S. Patent Application 09/472,762. Specifically, Applicant requests review of

- I. The rejection of independent claims 1, 3, and 5 under 35 U.S.C. § 102(b) as being anticipated by Unger (US 5,721,910), and the rejection of independent claim 7 under 35 USC §103(a) as being unpatentable over Unger; and
- II. The rejection of claims 2, 4, 6, and 8 under 35 USC 103(a) as being unpatentable over Unger for the same reasons cited in the §102 argument and further in view of MacPhail, US 5,107,419.

I. The Examiner has not made a prima facie case for a rejection under 35 USC § 102(b) based on the Unger reference because Unger does not teach each and every claim limitation of claims 1, 3, 5 and 7 as arranged in those claims.

This discussion refers generally to claim limitations in independent method claim 1, but applies equally to independent claim 3 directed to a computer system, independent claim 5 directed to a computer program, and independent claim 7 directed to a method for transferring a computer program product from one or more first computers to a second computer.

A. Tabular comparison of claim elements with teachings in the Unger reference.

To aid in an understanding of the deficiencies of the rejections of independent claims 1, 3, 5 and 7 based on Unger, Applicants provide the following table to indicate which claim elements Applicant believes are not taught in Unger and where relevant passages may be found in the record. Because some documents received by Applicant do not have a "paper" number on them, reference is made to a document by its filing or mailing date.

Claim 1 limitations	Passages cited in Unger as teaching limitation	Reference to argument previously made
loading the document into storage, said loaded document having a document category;		
determining the document category of said loaded document;	Col. 3, lines 9 – 15, referring to the "expert technical searches" (ETS).	Applicants agree that Unger teaches this element. See Reply filed by applicant 1/11/2005, page 9.
extracting information from said loaded document indicating at least one of a document date, a document transaction type and a document identifier;	Col. 1, lines 21-24; col. 6., lines 48-51; col. 7, lines 26-51, 55 -65; col. 8, lines 52-62; col. 10, lines 34-65	Not taught in Unger: See Reply filed by applicant 1/11/2005, pages 10-11.
applying to said loaded document at least one document handling procedure associated with the document category of said loaded document;	Col. 3, lines 22-28; col. 4, lines 44-57; col. 7, lines 40-46	Not taught in Unger: See Reply filed by applicant 1/11/2005, pages 11 –13.
said document handling procedure linking said loaded	Col. 4, lines 44-57; col. 5, lines 17-35; col. 6,	Office Action mailed 10/13/04 at page 7 states

document to at least one of said plurality of stored documents using the at least one of the document date, the document transaction type and the document identifier extracted from said loaded document.	lines 48-51; col. 7, lines 26-51, 55-65; col. 8, lines 52-67; col. 9, lines 1-4, 54-60; col. 10, lines 34-65.	that the document processing rule (now document handling procedure) is the ETS.
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- B. The Office Actions erroneously recite the "expert technical searches" in the Unger reference as teaching both the elements of determining a document category and applying a document handling procedure.

Office Actions have recited, and Applicant agrees, that Unger teaches the element of "determining the document category of the loaded document" at col. 3, lines 9 – 15. This passage states:

This database disaggregates a set of patents and/or technical documents into discrete technical categories by use of a set of pre-defined search protocols which match the scientific or technical concepts within the model. The pre-determined search strategies automatically categorize the set of technical documents to fit the multidimensional hierarchical model of a scientific or business discipline.

(Emphasis added.) In the Unger disclosure, technical documents, such as patents or scientific or technical publications, or abstracts of those patents or publications, are assigned to one or more categories within the hierarchical model (col. 2, lines 61 – 65) using the set of expert technical and/or scientific searches (ETS) to categorize each document. As clearly illustrated in the examples described in cols. 7 – 8, a user of the database disclosed in Unger first creates a model of categories and then uses the ETS to find documents to fit the categories. The ETS use all the expertise of a skilled technical searcher and capture that expertise in a set of pre-defined search strategies. Col. 7, lines 25 – 27. Then the searches are applied to a set of technical documents to populate the database. See col. 7, lines 52 – 67 and the text of claim 8 at col. 13.

Claim 1 of the subject invention requires applying to the loaded document at least one document handling procedure associated with the document category of said loaded

document. As stated in the Reply filed by Applicant on January 11, 2005, the step of applying the document handling procedure is distinct from, and follows, the step of determining the document category. The document category must be known before the applying step because the document handling procedure applied to the loaded document is one associated with the document category of the loaded document.

Applicants therefore believe that past Office Actions have been in error when they recite that Unger teaches applying at least one document handling procedure (terminology in past Replies referred to "document processing rule") associated with the document category by applying the expert technical searches (ETS) to a document. The ETS cannot teach both the step of determining the document category and the step of applying a document handling procedure associated with the document category. Thus, portions of Unger recited as teaching this element do not in fact teach the "applying" claim element.

In addition, the final "applying" claim element requires linking the loaded document to at least one stored document. The passages in Unger recited for this teaching also do not actually teach any further linking of one document to another in the database.

II. The Examiner has recited an improper motivation for combining the Unger reference with the MacPhail reference.

Dependent claims 2, 4, 6, and 8 have been rejected under 35 USC 103(a) as being unpatentable over Unger for the same reasons cited in the §102 argument and further in view of MacPhail, US 5,107,419. MacPhail is cited for teaching that the processing rule includes retention criteria for determining how long to save a document. The Office Action states, as motivation for the combination of Unger and MacPhail, that "MacPhail's teaching of using retention criteria to determine whether the documents in the document storage exceeds expiration date can help the processing rule in Unger's system to automatically delete documents that are no longer needed to save system storing space."

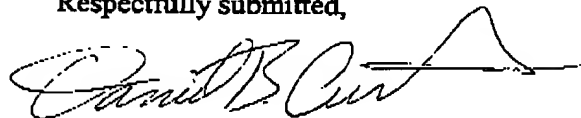
In the Reply filed by Applicant on January 11, 2005 Applicant asserted that (1) Unger appears to teach away from establishing any sort of retention scheme for the records in the technical database; and (2) the database of documents in Unger is not suitable for the specific retention method disclosed in MacPhail. A person of ordinary skill in the art would not look to the MacPhail reference to develop a retention scheme for the technical documents in the

database taught in Unger. The motivation to make the combination cited in the Office Action is simply not plausible. The reader is directed to the Reply filed by Applicant on January 11, 2005 at pages 14 – 16 for the complete text of the argument.

The Office Action mailed June 9, 2005 discusses Applicant's argument with respect to the MacPhail reference at pages 9 -10 and seems to have misunderstood Applicant's argument. Nothing in Applicant's argument suggests that Applicant believes that the MacPhail reference is "nonanalogous art." The June 9, 2005 Office Actions states at page 10 that "only administrator or the user who file the document to the system can set to time to retain the document and that the document that expires the time of retention is deleted when it is not needed, not by the control of other users." Applicant argues that this is precisely what is implausible about the MacPhail retention scheme as applied to the Unger database disclosure: The documents in the Unger system are not filed in the data base by individual users; the database is populated with documents through use of the ETS. Combining the retention scheme in MacPhail to the data base in Unger would allow a user who did not necessarily store a technical document in the data base to establish a retention scheme for the technical document to the detriment of other users.

Should any additional issues remain, or if I can be of any additional assistance, please do not hesitate to contact me at (650) 812-4259.

Respectfully submitted,



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